

REMARKS

This paper is filed in response to the final official action dated October 19, 2006. This paper is timely-filed.

Claims 1-24 are pending. Claims 1, 3-5, 8-9, and 23 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,706,669 to Okada ("Okada") in view of U.S. Patent No. 5,649,999 to Wang ("Wang").

Claims 6 and 7 have been rejected under 35 U.S.C. §103(a) as obvious over Okada in view of either U.S. Patent No. 4,172,604 to Keeler ("Keeler") or U.S. Patent No. 4,365,035 to Zabiak ("Zabiak"). Claims 1-5, 8-14, 17, 18, 23, and 24 have been rejected under 35 U.S.C. §103(a) as obvious over Okada in view of Wang and U.S. Patent No. 5,196,243 to Kawashima ("Kawashima"). Claims 6, 7, 15, and 16 have been rejected under 35 U.S.C. §103(a) as obvious over Okada in view of Wang and Kawashima, and further in view of Keeler or Zabiak.

Claims 19-22 have been objected to, but are allowable in substance.

Claims 1, 10, and 24 have been amended to recite "wherein the color changing correction fluid changes color upon drying." Support may be found variously throughout the application, for example, at page 1, lines 9-12. Claim 24 has also been amended to recite "or a volatile acid." Support may be found, for example, in original claim 10. No new matter has been added.

Claims 19 and 21 have been amended to be in independent form. The Office is authorized to charge our deposit account no. 13-2855 in the amount of \$400 for two additional independent claims in excess of three.

Applicants respectfully submit that the present amendments do not affect the allowability of claims 19-22. Accordingly, claims 19-22 are now in condition for allowance, and applicants respectfully request an indication of same.

Applicants further respectfully submit that the accompanying amendments are proper under 37 C.F.R. §1.116 practice and should be entered because the rejections set forth in the previous office action have been overcome. Moreover, these amendments should be entered because they do not present new issues requiring further consideration or search. Finally, the amendments should be entered because they place the application in condition for allowance (or in better condition for appeal).

The bases for the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application, as amended, is solicited in view of the following remarks.

**CLAIM REJECTIONS – 35 U.S.C. §102**

Claims 1, 3-5, 8-9, and 23 have been rejected as anticipated by Okada in view of Wang. The applicants respectfully traverse the rejections.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See*, for example, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity.

Okada discloses a “method for leaving a marking on a fabric at a prescribed point in order to indicate a sewing position.” *See* Okada at column 1, lines 10-13. The inventor indicated that the marking agent *must* “provide a clear and distinct mark on each fabric piece of any color” and “provide a mark which can be easily erased when required.” *Id.* at column 2, lines 8-19. The marking agent is comprised of a “inorganic pigment which is soluble in acid and/or base ... (and which is present) in an amount sufficient to provide a color mark on each fabric piece.” *Id.* at column 2, lines 27-31. Thus, the marking composition retains its initial color after application. The solubility of the inorganic pigment allows a mark made with the composition to be eliminated by contact with the acid or base. *Id.* at column 2, lines 64-68.

Okada further contemplates utilizing an acid-base indicator in the marking composition:

*If a white pigment which is soluble only in either acid or base is selected as inorganic pigment and if an acid-base indicator is further incorporated which provides a color in either acidic region or basic region and is colorless in the other one of these regions, marking compositions of various colors are obtained by adjusting the pH of the composition so as to cause colors to derive from the indicator.*

*Id.* at column 2, lines 38-45 (emphasis added). Again, Okada merely contemplates marking compositions which retain their initial color after application. It would be contrary to Okada’s intended purpose to provide a mark having a color derived from the indicator if the compositions disclosed therein were to change color upon drying

(i.e., after application). Accordingly, Okada does not disclose or suggest a fluid which changes color upon drying, as recited by claims 1, 3-5, 8-9, and 23.

For the foregoing reasons, the applicants respectfully submit that the anticipation rejections of claims 1, 3-5, 8-9, and 23 over Okada have been overcome and should be withdrawn.

**CLAIM REJECTIONS – 35 U.S.C. §103(a)**

Claims 6 and 7 have been rejected as obvious over Okada in view of either Keeler or Zabiak. Claims 1-5, 8-14, 17, 18, 23, and 24 have been rejected as obvious over Okada in view of Wang and Kawashima. Claims 6, 7, 15, and 16 have been rejected as obvious over Okada in view of Wang and Kawashima, and further in view of Keeler or Zabiak. The applicants respectfully traverse the rejections.

A *prima facie* case of obviousness must satisfy three legal requirements. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. §2143. These criteria have not been satisfied with respect to pending claims 1-14.

The deficiencies of Okada are discussed above. It would be contrary to Okada's intended purpose to provide a mark having a color derived from the indicator if the compositions disclosed therein were to change color upon drying (i.e., after application). Accordingly, the skilled artisan would not be motivated to modify Okada to provide a composition which changes color upon drying, as recited by claims 1-18, 23, and 24.

Accordingly, the applicants respectfully submit that a *prima facie* case of obviousness has not been established, and that the various obviousness rejections of claims 1-18, 23, and 24 over Okada have been overcome and should be withdrawn.

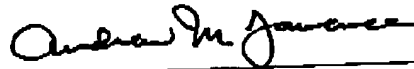
**CONCLUSION**

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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January 19, 2007



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